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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,635	01/27/2004	Steven E. Morton	ECSIX 104 DIV 2	2257
2555	7590	07/27/2006	EXAMINER	
KREMBLAS, FOSTER, PHILLIPS & POLLOCK 7632 SLATE RIDGE BOULEVARD REYNOLDSBURG, OH 43068			CHEVALIER, ALICIA ANN	
			ART UNIT	PAPER NUMBER
			1772	
DATE MAILED: 07/27/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/765,635

Applicant(s)

MORTON, STEVEN E.

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006 and 01 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

Request for Continued Examination

1. The Request for Continued Examination (RCE) under 37 CFR 1.53 (d) filed on May 1, 2006, is acceptable and a RCE has been established. An action on the RCE follows.
2. Claims 39 and 40 are pending in the application, claims 1-38 and 41-42 have been cancelled.
3. Amendments to the claims, filed on May 10, 2006, have been entered in the above-identified application.

REJECTIONS

4. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 39 and 40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

Art Unit: 1772

art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In the instant case amended claim 39 contains the limitation, “a particulate layer ... is at least two particulate particles thick.” The specification does not disclose the thickness of the particulate layer, therefore this limitation is considered new matter. The only discussion in the specification of thickness is on page 11, lines 5-6, where it discusses the total thickness of the wear-resistant coating. The specification is also silent about the size of the particles or the matrix thickness above the fibers. Furthermore, the drawings do not support this limitation since figure 9 shows that the particle layer is discontinuous and sometimes not even show one particle thick.

The new matter must be deleted.

Claim Rejections - 35 USC § 102

7. Claims 39 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Sweeney (U.S. Patent No. 5,209,968).

Sweeney discloses a modular flooring unit (*floors panels, col. 5, line 63*). The unit comprises a planer matrix formed from a matrix material (*cementations slurry binder, col. 3, line 30 and line 35*), a reinforcing fiber layer (*col. 3, lines 33-35*), and a particulate layer (*col. 3, lines 26-32*). The reinforcing fibers are embedded in the matrix material for reinforcing the matrix (*figures 2 and 3*). The particulate layer is mounted to a major surface of the layer reinforcing fibers and is at least two particulate particles thick and wherein the matrix material surrounds at

Art Unit: 1772

least some of the particulate particles for mounting the particulate layer to the reinforcing fiber layer (*figures 2 and 3*).

The unit is deemed to be a discrete size and weight that can be lifted by a human, because the reference discloses various intended uses for the composite (*col. 5, line 60 through col. 6, line 5*) that have sizes ranging from very small to very large. Furthermore, the reference discloses in one embodiment the composite panel is 8' x 4' x 2.5" thick panel weighs approximately 7 pounds per sq. ft. (*col. 4, lines 21-23*), which is approximately 225 pound per panel and capable of being lifted by a human.

The particulate layer mounted to the matrix is deemed to form a traffic-bearing surface of the flooring unit. This is because the matrix is completely surrounded by the matrix material, i.e. mounted to the matrix, and the whole material forms a floor panel.

Note: It is noted that Applicant's may be attempting claim that the some of the particles are on an outer surface of the matrix. However, Applicant never claims that the particles are not completely embedded in the matrix. That is Applicant only claims "wherein the matrix material surrounds at least some of the particulate particles," which encompasses that particles being completely surrounded by the matrix material. Applicant never claims that at least some of the particulate particles are not covered by the matrix. It is further noted that the examiner is not suggesting the Applicant use this language in the claims.

Art Unit: 1772

ANSWERS TO APPLICANT'S ARGUMENTS

8. Applicant's arguments in the after final response filed May 1, 2006 regarding the 35 U.S.C. 112, first paragraph rejection in the office action mailed November 30, 2005 of record have been carefully considered but are deemed unpersuasive.

Applicant repeatedly argues that figure 9 shows the limitation, "a particulate layer ... is at least two particulate particles thick." The examiner still maintains that she cannot distinguish the particles from the matrix. The drawing is unclear for supporting that particular limitation.


Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac
7/21/06



**ALICIA CHEVALIER
PRIMARY EXAMINER**